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08/882,197 06/25/97 GREER

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EXAMINER

LM02/0709

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ART UNIT

PAPER NUMBER

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
08/882,197

Applicant(s)

Greer et al

Examiner

Penny Caudle

Group Art Unit

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☒ Responsive to communication(s) filed on Jun 8, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-20 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-20 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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### **DETAILED ACTION**

1. In response to the Amendment filed on June 14, 1999, claims 1, 3, 7, 14 and 15 have been amended. Claims 1-20 are pending.

#### ***Claim Objections***

2. Claims 1 and 20 are objected to because of the following informalities:

As per claim 1, the phrase "a content provider ad banners"(line 2) should read "content provider ad banners", the phrase "which receives" which has been deleted from line 3 should be replaced, the word "obtains" should be insert between "collecting agent" and "user information" in line 5, and the word "transmits" which has been deleted from line 6 should be replaced.

As per claim 20, the phrase "the plurality of keys" lacks proper antecedent basis and should either read "a plurality of keys" or the dependency should be on claim 19 instead of 18. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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4. Claims 1 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear what the triggering agent determines with respect to the user information as claimed in lines 7-8 of claim 1 and lines 9-10 of claim 15("a triggering agent...and determine the user information"). For the purposes of this examination the claim is interpreted to as follows: "to determine whether the user information is significant".

5. Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim does not accomplish what the preamble sets forth. It is unclear how a collecting agent to obtain user information including hardware data for a hardware profile and software data for a software profile and a triggering agent to discern the user information obtained by the collecting agent, provide for a target computer to receive advertising content.

***Claim Rejections - 35 USC § 103***

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 1-6 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis et al (U.S. 5,796,952) in view of Fitzpatrick et al (U.S. 5,423,043).

As per claim 1, Davis et al discloses an advertising system comprising the following:

-content provider ad banners, as shown in Figure 6 (Server B);

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-a target computer which receives the ad banners, as shown in Figure 6 (Client);

-a collecting agent transmitted from the content provider to the target computer, the collecting agent obtains user information including data for a hardware profile and transmits the user information to the content provider, as stated in column 4 lines 37-63, "...a tracking program is embedded in a file which is downloaded from a server to a client...and runs on the client to monitor various indicia...in order to track the user's interaction with and use...After monitoring the user's interaction with and use...the tracking program then automatically sends the information acquired from the client back to the server for storage and analysis..." and column 9 lines 41-45, "...other information concerning the client computer may be automatically acquired and sent to the server, such as the type of hardware in the client computer and various resources that are resident on the client computer.";

-a program running on the content provider, the program organizes the user information and updates a user specific database as stated in column 4 lines 64-67, "The acquired information is preferably stored on a server and used to build historical profiles of individual users, to serve out highly targeted information based upon user profiles..."

Davis et al fails to disclose a triggering agent to discern the user information obtained by the collecting agent and to determine whether the user information is significant. Fitzpatrick et al disclose a system wherein an agent is provided to monitor, build, maintain, and recall links based on prior actions and user choices(col. 2 lines 27-32). In addition, the agent may act continuously to record actions and build links passively or on demand based on user specific user signals such

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as a trigger. Therefore it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to implement the advertising system taught by Davis with the addition of a triggering agent as disclosed by Fitzpatrick et al in order to prevent storage of duplicate information in the user profile.

As per claim 2, Davis et al and Fitzpatrick et al disclose all the limitations as set forth in claim 1 above. In addition Davis et al disclose the user information further includes data for a software profile. As stated in column 4 lines 64-67, "The acquired information is preferably stored on a server and used to build historical profiles of individual users, to serve out highly targeted information based upon user profiles..."

As per claim 3, Davis et al and Fitzpatrick et al disclose all the limitations as set forth in claim 1 above. In addition Davis et al disclose a user profile including the hardware profile which is updated by the program running on the content provider. As shown in Figure 6 items S603A and S611A and stated in column 18 lines 34-37, "...the client profile is created automatically using information acquired by the tracking program and one or more CGI scripts and is stored in the server database..." and 9 lines 41-45, "...other information concerning the client computer may be automatically acquired and sent to the server, such as the type of hardware in the client computer and various resources that are resident on the client computer.".

As per claim 4, Davis et al and Fitzpatrick et al disclose all the limitations as set forth in claim 1 above. In addition Davis et al disclose the user profile including information on CPU processing speed. As stated in column 9 lines 41-45, "...other information concerning the client

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computer may be automatically acquired and sent to the server, such as the type of hardware in the client computer and various resources that are resident on the client computer.”.

As per claim 5, Davis et al disclose all the limitations as discussed in paragraph 3 or paper number 2.

As per claim 6, Davis et al and Fitzpatrick et al disclose all the limitations as set forth in claim 1 above. In addition Davis et al disclose the user profile including a subkey indicating a processor speed of a processor in the target computer. As stated in column 9 lines 41-45, “...other information concerning the client computer may be automatically acquired and sent to the server, such as the type of hardware in the client computer and various resources that are resident on the client computer.”.

As per claim 15, Davis et al disclose a target computer to receive advertising content, the system comprising:

-a collecting agent to obtain user information including hardware data for a hardware profile and software data for a software profile, as stated in column 4 lines 37-63, “...a tracking program is embedded in a file which is downloaded from a server to a client...and runs on the client to monitor various indicia...in order to track the user’s interaction with and use...After monitoring the user’s interaction with and use...the tracking program then automatically sends the information acquired from the client back to the server for storage and analysis...” and in column 9 lines 41-45, “...other information concerning the client computer may be automatically

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acquired and sent to the server, such as the type of hardware in the client computer and various resources that are resident on the client computer.”;

Davis et al fails to disclose a triggering agent to discern the user information obtained by the collecting agent and to determine whether the user information is significant. Fitzpatrick et al disclose a system wherein an agent is provided to monitor, build, maintain, and recall links based on prior actions and user choices(col. 2 lines 27-32). In addition, the agent may act continuously to record actions and build links passively or on demand based on user specific user signals such as a trigger. Therefore it would have been obvious to one of ordinary skill in the art at the time of the applicant’s invention to implement the advertising system taught by Davis with the addition of a triggering agent as disclosed by Fitzpatrick et al in order to prevent storage of duplicate information in the user profile.

8. Claims 7-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis et al (U.S. 5,796,952).

As per claim 7, Davis et al disclose a method of communicating advertising information comprising the following:

- creating a user profile, as stated in column 4 lines 64-65, “The required information is preferably stored on a server and used to build historical profiles of individual users...”;

- transmitting an ad banner from a content provider to a target computer, as stated in column 13 lines 54-56, “In the case of a Web page provided with an ad banner, the tracking program...”;



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-collecting user information at the target computer including data for a hardware profile, as stated in column 4 lines 46-51, "The tracking program...and runs on the client to monitor various indicia..." and in column 9 lines 41-45, "...other information concerning the client computer may be automatically acquired and sent to the server, such as the type of hardware in the client computer and various resources that are resident on the client computer.";

-transmitting the user information from the target computer to the content provider, as stated in column 4 lines 56-59, "After monitoring the user's interaction with and use...the tracking program then automatically sends the information acquired from the client back to the server for storage and analysis...";

-filtering the user information to create relevant data, as stated in column 14 lines 47-48, "The tracked information may be used to assemble resources geared toward the user's interest.";

-arranging the relevant data to create a modified user specific database, as stated in column 16 lines 5-9, "A second database that may be created is indexable by individual client, and includes information concerning individual client's interests and preferences...";

-generating a second user ad banner corresponding to the modified user specific database, as stated in column 15 lines 3-5, "Since the user has previously expressed a greater interest in sports, sports-related advertisements may therefore be targeted to that user.".

Davis et al fail to explicitly disclose determining whether the user information is significant.

Official Notice is given that the practice of data filtering or mining for determine significant

information from stored user data is old and well known in the art. Therefore it would have been

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obvious to one of ordinary skill in the art at the time of the applicant's invention to implement the system taught by Davis et al with the added step of determining whether the user information is significant in order to prevent storage of useless or duplicate data.

As per claim 8, Davis et al disclose all the limitations as set forth in claim 7 above. In addition Davis et al disclose the operation of transmitting an agent from the content provider to the target computer. As stated in column 4 lines 37-40, "...a tracking program is embedded in a file which is downloaded from a server to a client."

As per claim 9, Davis et al disclose all the limitations as set forth in claim 7 above. In addition Davis et al disclose the collecting operation is executed by an agent running on the target computer. As stated in column 4 lines 45-46, "The tracking program is downloaded from a server and runs on the client..."

As per claim 10, Davis et al disclose all the limitations as set forth in claim 8 above. In addition Davis et al disclose the agent being transmitted with the ad banner. As stated in column 14 lines 22-30, "...the tracking program is downloaded...with the HTML document in response to a TCP/IP client request...displaying both the Web page and the ad banner embedded in the Web page..."

As per claim 11, Davis et al disclose all the limitations as set forth in claim 9 above. In addition Davis et al disclose the agent is independent of a browser executing on the target computer. As stated in column 17 lines 45-46, "In addition the tracking program need not be a program that executes on the client computer."

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As per claim 12, Davis et al disclose all the limitations as set forth in claim 7 above. In addition Davis et al disclose the ad banner is transmitted in an Internet protocol format. As stated in column 14 lines 22-30, "...the tracking program is downloaded...with the HTML document in response to a TCP/IP client request...displaying both the Web page and the ad banner embedded in the Web page...".

As per claim 13, Davis et al disclose all the limitations as set forth in claim 7 above. In addition Davis et al disclose the generating of the second user ad banner involves applying rules which include dynamic information profiling the target computer user. As stated in column 14 lines 62-65, "...user profile database may be used to determine which of the resources is to be downloaded to that client using simple logical processing instructions.".

9. Claims 14 and 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldhaber et al (U.S. 5,794,210) in view of Davis et al (U.S. 5,796,952) further in view of Fitzpatrick et al (U.S. 5,423,043).

As per claim 14, Goldhaber et al disclose a content provider for providing advertising over a network comprising the following:

- a plurality of user profiles, each user profile including user data corresponding to a target computer account, as shown in Figure 7 item 124 and stated in column 13 lines 34, "We keep a personal profile for each of our members";

- a munging agent which updates each user profile based on data transmitted from an agent, as shown in Figure 11A items 190 and 192;

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-a rule set associated with each user profile including rules generated from the user data and a rulebook which selects data to be transmitted from an advertising content database using the rule set, as stated in column 15 lines 31-47, "Matching of interest profiles 124 with ads can be performed using "relevance indexing"...".

Goldhaber et al fail to disclose that the rulebook includes condition-action pairs. However, Davis et al disclose an advertising system consisting of user profiles which are used to generate user specific advertisements based on logical rules. As stated in column 14 lines 62-65, "...a user profile database may be used to determine which of the resources is to be downloaded to that client using simple logical processing instructions.". Therefore it would have been obvious at the time of the applicant's invention to implement the system taught by Goldhaber et al with the use of condition-action pairs, i.e. logical if-then instructions, as taught by Davis et al in order to provide the user with the most relevant advertising for their particular hardware and interest.

Goldhaber et al and Davis et al fail to disclose a triggering agent to discern the user information obtained by the collecting agent and to determine whether the user information is significant. Fitzpatrick et al disclose a system wherein an agent is provided to monitor, build, maintain, and recall links based on prior actions and user choices(col. 2 lines 27-32). In addition, the agent may act continuously to record actions and build links passively or on demand based on user specific user signals such as a trigger. Therefore it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to implement the system taught by

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Goldhaber et al and Davis et al with the addition of a triggering agent as disclosed by Fitzpatrick et al in order to prevent storage of duplicate information in the user profile.

As per claim 16, Goldhaber et al, Davis et al, and Fitzpatrick et al disclose all the limitations as set forth in claim 14 above. In addition Davis et al discloses a condition-action pair includes a hardware characteristic of a target computer associated with the target computer account. As stated in column 9 lines 41-45, "...other information concerning the client computer may be automatically acquired and sent to the server, such as the type of hardware in the client computer and various resources that are resident on the client computer."

As per claim 17, Goldhaber et al, Davis et al, and Fitzpatrick et al disclose all the limitations as set forth in claim 16 above. Goldhaber et al, Davis et al, and Fitzpatrick et al fail to disclose that the hardware characteristic is a modem speed. Official Notice is given that the use of modem speed in hardware profiles for directing user specific advertising to users is old and well known in the art, as evidenced by the Newswire article "C/NET: The Computer Network Unveils Revolutionary Internet Advertising Tools that Allow Custom Banner Ad Delivery Based on Demographic Information". Therefore it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to implement the system taught by Goldhaber et al, Davis et al, and Fitzpatrick et al with the addition of modem speed as a hardware characteristic in order to the user with the most relevant advertising for their particular interest and hardware.

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As per claim 18, Goldhaber et al, Davis et al, and Fitzpatrick et al disclose all the limitations as set forth in claim 16 above. In addition Davis et al disclose when the hardware characteristic satisfies a first condition, high fidelity ad content is transmitted, and when the hardware characteristic satisfies a second condition, lower fidelity ad content is transmitted. As stated in column 15 lines 33-36, "...and the previously constructed historical database profile (S607B), different information (images, sounds, text, etc.) May be returned to the applet."

As per claim 19, Goldhaber et al, Davis et al, and Fitzpatrick et al disclose all the limitations as set forth in claim 14 above. In addition Davis et al discloses the user profile includes at least one rule page including a plurality of keys, the plurality of keys includes a hardware profile to indicate hardware capabilities of a target computer associated with the target computer account. As stated in column 9 lines 41-45, "...other information concerning the client computer may be automatically acquired and sent to the server, such as the type of hardware in the client computer and various resources that are resident on the client computer."

As per claim 20, Goldhaber et al, Davis et al, and Fitzpatrick et al disclose all the limitations as set forth in claim 18 above. Goldhaber et al, Davis et al, and Fitzpatrick et al fail to disclose that the plurality of keys includes a software profile to indicate software used by the target computer account. Official Notice is given that the inclusion of software used in user profiles is old and well known in the art, as evidenced by the Newswire article "C/NET: The Computer Network Unveils Revolutionary Internet Advertising Tools that Allow Custom Banner Ad Delivery Based on Demographic Information". Therefore it would have been obvious to one

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of ordinary skill in the art at the time of the applicant's invention to implement the system taught by Goldhaber et al, Davis et al, and Fitzpatrick et al with the addition of software profiles in order to the user with the most relevant advertising for their particular interest and hardware.

*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Penny Caudle whose telephone number is (703) 305-0756. The examiner can normally be reached Monday-Thursday from 6:30 AM to 5:00 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allen MacDonald, can be reached at (703) 305-9708.

The fax number for Formal or Official faxes to Technology Center 2700 is (703) 308-9051 or 9052. Draft or Informal faxes for this Art Unit can be submitted to (703) 308-1396.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

plc

July 1, 1999



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SUPERVISORY PATENT EXAMINER